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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,516	07/16/2001	Nathalie Mougin	P 0281573 B00/2208 US	2271

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PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,516

Applicant(s)

MOUGIN ET AL.

Examiner

Michael A. Willis

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's response of 23 August 2002 is entered.

Election/Restrictions

Applicant's election with traverse of Group 1, claims 1-11 and 13-15, as the elected invention in Paper No. 8, submitted 23 August 2002, is acknowledged. The traversal is not found persuasive because reasons for the traversal are not given. The requirement is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of the polyurethane polymer disclosed in Example 1 at pages 14-15 of the specification as the species for purposes of examination is acknowledged. The traversal is not found persuasive because reasons for the traversal are not given. The requirement is still deemed proper and is therefore made FINAL.

Claims 1-15 are pending. Claim 12 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 1-11 and 13-15 are examined as they read on the elected species of polymer disclosed in Example 1 at pages 14-15 of the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1617

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is rejected for lack of antecedent basis for the phrase "R5 and R7 have the same meanings as R2 defined in Claim 7". Claim 7 does not define R2, so there is no antecedent basis for the indicated phrase.

Claim 11 is rejected for being vague due to the phrase "a group derived from a polymer selected from the group consisting of polyethers, sulphonated polyesters and sulphonated polyamides". The metes and bounds of the phrase "derived from" are unclear. It is unclear if, for example, a carbonyl unit isolated from the degradation of such polymers would meet the limitation of "derived from".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1617

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laine et al (US Pat. 4,617,341).

The instant claims are directed at amphiphilic cationic associative polyurethanes of formula (I) and compositions comprising the polymers. The claims are examined as the read on the elected species of polymer of Example 1 of pages 14-15 of the specification.

Laine teaches polyurethane latex sizing agents and their method of manufacture. A variety of polymers are encompassed by the formula taught by Laine (see col. 1, line 46 through col. 2, line 36). Terminal R groups such as R3 are alkyl radicals containing at least 7 carbon atoms. Linking R groups such as R2 include alkylene radicals containing C2 radicals. The starting materials include tertiary dialkanolamines (see col. 4, lines 1-45). The resulting polymers are dispersed in water to form a latex (see claim

Art Unit: 1617

4). Water meets the limitation of claim 13 of a cosmetically acceptable medium. With respect to the preamble of claim 13 of "a cosmetic composition", the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The reference lacks an identical example to the claimed species.

While the reference lacks disclosure of the exact species as claimed, the polymers taught by Laine encompass the presently claimed species. While some picking and choosing is required in order to obtain the claimed species, Laine teaches the importance of various properties such as the tension between hydrophobicity and hydrophilicity in selecting the various subunits of the polymer (see col. 4, lines 53-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the polymers of Laine by selecting various subunits as taught by Laine in order to optimize the hydrophobic/hydrophilic balance as taught by Laine in order to benefit from optimized polymers. The motivation is provided by the teachings of Laine, which teach the desirability of polymers which can form a stable latex (see col. 2, line 65 through column 3, line 2).

Art Unit: 1617

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mimura et al (US Pat. 4,233,359) and De La Poterie et al (US Pat. 5,571,858) teach polyurethanes, but lack the substituents of the elected species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
November 27, 2002


SREENI PADMANABHAN
PRIMARY EXAMINER
12/1/02